

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the undersigned and Vinod Nama would like to thank Examiner Tsui for courtesies extended during the telephone interview on April 14, 2011 ("the telephone interview").

Rejections under 35 U.S.C. § 102

Claims 1, 2, 5-7, 9, 10, 13-15, 17 and 20 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 7,373,313 ("the Kahle patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1, 2, 5, 6, 9, 10, 13, 14 and 17

Independent claim 1, as amended, is not anticipated by the Kahle patent because the Kahle patent fails to disclose a computer-implemented method comprising: (a) accepting information of an ad which includes ad content; (b) using at least one of terms, concepts and categories from the content of the ad to determine relevant content, from a content server, in addition to content of the ad, wherein the determined relevant content is one of (A) a news story, (B) a review, or (C) a user group message; (c) combining, **automatically and regardless of any user input**, at least a portion of content of the ad, from the ad server, and at least a portion of the determined relevant content, from the content server, with page content, **to generate combined information**; and (d) serving an electronic document including the combined information to induce display of the electronic document on a user device, wherein the page content is (A) not directly used to determine the determined relevant content and (B) different than the content of the ad.

During the telephone interview, Examiner Tsui indicated that the above amendments to claims 1 and 9 would distinguish these claims over the Kahle patent since the claims now more clearly recite that the combined information is generated and then included in an electronic document served to a user device.

Further, exemplary embodiments consistent with claim 1, as amended, combine the page content, at least a portion of the ad content, and the at least a portion of

the determined relevant content automatically and regardless of any user input. That is, the exemplary embodiments do not wait to receive, or depend on, user input for presenting the combined information to the user.

In contrast, the Kahle patent states that "[s]election of a display element causes the client program to retrieve product-related data." (Column 1, lines 49-51 of the Kahle patent.) More specifically, the Kahle patent states:

The client program displays a user-selectable display element for each identified product. **Selection of a display element causes the client program to retrieve product-related data from the data server and to present the data in conjunction with the web page.** [Emphasis added.]

(Column 1, lines 47-52) Also, Figures 2A-2D and 3A-3M of the Kahle patent illustrate that the product related data is retrieved (and presented) in response to a user selection of a display element. Consequently, the Kahle patent fails to disclose combining, automatically and regardless of any user input, the page content, the at least a portion of the ad content, and the at least a portion of the determined relevant content as recited in claim 1, as amended. Thus, the Kahle patent fails to anticipate claim 1, as amended, for at least the foregoing reason.

Additionally, claim 1 recites that the page content is **not directly used** to determine the determined relevant content. In contrast, the Kahle patent states:

In one embodiment, product-related data is collected using list-based techniques in which the **text of web pages is scanned** for products identified in a product list. In one embodiment, a common structure of web pages, preferably within a web site, is used to identify product-related data. [Emphasis added.]

(Column 2, lines 7-11) The Kahle patent further states:

The client program 124 preferably **identifies the representation 301 of the product 303 on the web page 302** by locating the first instance of the original product name. [Emphasis added.]

(Column 7, lines 26-30) It also states:

In accordance with these techniques, the data generation module 806 preferably fetches web page after web page and **analyses each fetched web page to gather or collect product-related data.**

Run time techniques are used to gather information on-the-fly as the information is being requested. In one embodiment, the client program 124 sends the URL of a web page to the data server 140. The data generation module 806 then fetches the web page for itself (the same one as is displayed in by web browser) and **analyzes the web page.** The data generation module 806 then generates, on-the-fly, the data

that is returned to the client program 124 to be displayed in conjunction with the web page. [Emphasis added.]

(Column 18, lines 21-37) As can be appreciated, the Kahle patent "analyses each fetched web page to gather or collect product-related data" (Column 18, lines 22-24) and also states that "text of web pages is scanned for products" (Column 2, line 8). This is different from claim 1 which recites "the page content is (A) not directly used to determine the determined relevant content". Thus, the Kahle patent fails to anticipate claim 1 for at least this additional reason.

Independent claim 9, as amended, is similarly not anticipated. Since claims 2, 5, 6 and 17 depend from claim 1 and since claims 10, 13 and 14 depend from claim 9, they are similarly not anticipated.

Claims 7, 15 and 20

Independent claim 7 is not anticipated by the Kahle patent because the Kahle patent fails to disclose a computer-implemented method comprising: (a) accepting document content information; (b) using at least one of terms, concepts and categories of the document content information to retrieve relevant content in addition to content of the document, wherein the retrieved relevant content is one of (A) a news story, (B) a review, (C) a search query, or (D) a user group message; (c) **using the retrieved relevant content, retrieving further content, wherein the further retrieved content is at least one ad, received from an ad server, relevant to the retrieved relevant content;** and (d) combining at least a portion of

content of the document, at least a portion of the retrieved relevant content, and at least a portion of the retrieved further content for presentation to a user.

During the telephone interview, Examiner Tsui indicated that the foregoing amendments to claims 7 and 15 would more clearly distinguish these claims over the Kahle patent.

Further, exemplary embodiments consistent with method claim 7 relate to a ***two-step determination*** in which (1) additional content is retrieved using accepted document information, and (2) further content is retrieved using the retrieved additional content. Then, ***content of the accepted document, the additional content and the further content are combined for presentation to a user.*** As described in an example in the specification of the present application:

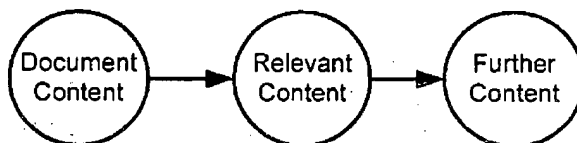
Referring to the short dashed arc in Figure 7, in an alternative embodiment, the best scoring items can be used to help determine relevant ads. For example, given a Web page 710 about theme parks ***[document information]***, a news item 720 from "current news" information sources 730 with a headline such as "Disney to Open Theme Park in Beijing Next Week" may be selected ***[additional content determined using the document information]***. The information selected 720 may be used to help target advertisements 740 to both the selected information and the content of the page:

'Buy Tickets to Beijing'

'Buy the book "Theme Parks in China"'

[further content determined using the additional content] As the foregoing example illustrates, information from (a) the target content, (b) the additional content, or (c) both can be used to determine content-relevant ads. [Emphasis added.]

(Page 17, line 35 through page 18, line 10 of the present application) The figure below illustrates an embodiment consistent with independent claim 7.



That is, the claimed invention recites using document content to retrieve relevant content and **further using** the retrieved relevant content to retrieve further content.

The Examiner alleges that the Kahle patent teaches using determined relevant content, determining further content relevant to the determined relevant content, citing Fig. 2B and Col. 20, lines 45-53. (See Paper No. 20101231, page 6.) The applicants respectfully disagree.

The Kahle patent states:

In accordance with these techniques, the data generation module 806 preferably fetches web page after web page and analyses each fetched web page to gather or collect

product-related data.

Run time techniques are used to gather information on-the-fly as the information is being requested. In one embodiment, the client program 124 sends the URL of a web page to the data server 140. The data generation module 806 then fetches the web page for itself (the same one as is displayed in by web browser) and analyzes the web page. The data generation module 806 then generates, on-the-fly, the data that is returned to the client program 124 to be displayed in conjunction with the web page. In another embodiment, the client program 124 can be configured to send a portion of or the whole web page directly to the data server 140 for analysis. In still another embodiment, the data generation module 806 generates code that is transmitted to and executed by the client program 124 in order to **generate product-related information**, such as the **identification of products** on a web page. [Emphasis added.]

(Col. 18, lines 20-40) It further states:

In still another embodiment, processes 400 (FIG. 4A) and 700 (FIG. 7A) are used in conjunction with the process 900 (FIG. 9A) to dynamically **identify bid or sale offers for previously identified products**. In accordance with this embodiment, the step 1002 is preferably added to the process 900. Consequently, when the server 140 queries the database 804 in the step 908, the server will be able to identify offers for bid or sale and incorporate links to the offers in the client bubble web page 532. [Emphasis added.]

(Col. 20, lines 45-53) The Kahle patent, however, **does not use the already generated product-related data/information** to identify the bid or sale offers. Thus, claim 7 is not anticipated by the Kahle patent for at least the foregoing reason. Similarly, independent claim 15 is not anticipated. Since claim 20 depends from claim 7, it is similarly not anticipated.

Rejections under 35 U.S.C. § 103

Claims 3, 11 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kahle patent and in further view of CNET.com, page 1, December 7, 2001 ("the CNET page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

As explained above, the Kahle patent fails to anticipate independent claims 1 and 9, as amended. The alleged disclosure of the CNET page fails to compensate for the deficiencies of the Kahle patent with respect to independent claims 1 and 9. Since claims 3, 11, and 18 depend from claims 1 or 9, these claims are similarly not rendered obvious by the Kahle patent and the CNET page.

Claims 4, 12 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kahle patent further view of MSN.com, page 1, December 7, 2000 ("the MSN page"). The applicants respectfully request that the

Examiner reconsider and withdraw this ground of rejection in view of the following.

As explained above, the Kahle patent fails to anticipate independent claims 1 and 9, as amended. The alleged disclosure of the MSN page fails to compensate for the deficiencies of the Kahle patent with respect to independent claims 1 and 9 (discussed above). Since claims 4, 12, and 19 depend from claims 1 or 9, these claims are similarly not rendered obvious by the Kahle patent and the MSN page.

Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kahle patent in further view of U.S. Patent Application Publication No. 2004/0015397 ("the Barry publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

As explained above, the Kahle patent fails to anticipate independent claims 7 and 15. The alleged disclosure of the Barry publication fails to compensate for the deficiencies of the Kahle patent with respect to independent claims 7 and 15. Since claims 21 and 22 depend from claims 7 and 15 respectively, these claims are similarly not rendered obvious by the Kahle patent and the Barry publication.

New claims

New claims 23 and 24 depend from claims 7 and 15, respectively, and further recite that the act of combining the at least a portion of content of the document, the at least a portion of the determined relevant content, and the at least a portion of the determined further content is performed before the page is presented to the user. This feature further distinguishes the claimed invention from the cited art. These new claims are supported by Figures 2-7 and their related description.

Conclusion

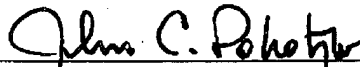
In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

May 5, 2011



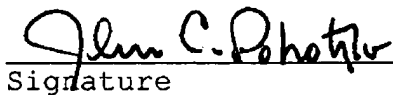
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